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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,383	02/02/2000	Phuong V. Luu	1775-1A	6132

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

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DATE MAILED: 06/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

ME11

**Office Action Summary**

Application No.

09/496,383

Applicant(s)

VAN LUU ET AL

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/31/01 & 03/18/02.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 26-31, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 26-31, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1) ***A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/18/02 has been entered.***

***Claim Rejections - 35 USC § 112***

2) ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

***The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***

3) ***Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

***The recited "wherein the adhesive composition may be adhered to a Yankee dryer such that a creped product manufactured on the Yankee dryer will exhibit a peel force----- when using a paper making machine having a speed of less than 150 feet per minute" per the claim supra constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited adhesive composition.***

***Claim Rejections - 35 USC § 102***

4) ***Th following is a quotation of th appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section mad in this Office action:***

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

**5) The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).**

**6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

**7) Claims 1-3, 26, 29-31, 34 & 35 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kotani'560 or Kotani'029 as per reasons clearly stated in the previous Office Action per paper no. 7, 07/30/01. Further, the release ability and spray ability of the compositions of each of Kotani is tenable and would be expected since the compositions of patentees are essentially the same as and made in essentially the same manner as the claimed compositions. Consult Best et al(195 USPQ 430).**

**Claim Rejections - 35 USC § 103**

8) *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

9) *The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:*

1. *Determining the scope and contents of the prior art.*
2. *Ascertaining the differences between the prior art and the claims at issue.*
3. *Resolving the level of ordinary skill in the pertinent art.*
4. *Considering objective evidence present in the application indicating obviousness or nonobviousness.*

10) *This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

11) *Claims 1-3, 26, 29-31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollenberg et al as per reasons clearly stated in the previous Office Action per paper no. 7, 07/30/01. Further, the adhesives of Hollenberg et al are taught as being easily removed and therefore meet the "releasability" property per claim 1. The*

*spray ability of the composition of Hollenberg is tenable since the composition carved out of Hollenberg et al is essentially the same as and made under essentially the same conditions as the claimed composition. See at least col. 1 of Hollenberg et al.*

**Claim Rejections - 35 USC § 103**

12) *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

13) *Claims 1-5, 26-31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smigo et al in combination with Hollenberg et al as per reasons clearly set forth in the previous Office Action per paper no. 7, 07/30/01. Further, the release ability and spray ability of the adhesive compositions of Smigo et al, as modified, is tenable since these modified compositions are essentially the same as and made in essentially the same manner as the claimed compositions.*

**Claim Rejections - 35 USC § 102**

14) *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

15) *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.***

***16) Claims 1-3, 26, 29-31, 34 & 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Greer et al(U.S. 5,230,774).***

***Greer et al disclose and exemplify the use of blends of cationic polymers and zirconium compounds in pulp and papermaking processes wherein, the ratio of cationic polymer to zirconium compound is about 4:1 to about 1:4. Greer et al further teach the use of the blends of cationic polymer, zirconium compound and water in pulp and papermaking processes which basically involve adding said combination to a cellulosic slurry. Greer et al therefore anticipate the instantly claimed invention with the understanding that the compositional components of Greer et al overlap in scope with the claimed compositional components, in both content and character. See, e.g., the Abstract, col. 1, lines 1-19, col. 2, lines 30-68 to col. 3, lines 1-68, col. 4, lines 1-63, col. 5, lines 15-60, col. 6, lines 43-66, col. 7, lines 1-15, the Runs and Claims of Greer et al.***

***It would be expected that the compositions of Greer et al would be releasably adhesive and sprayable since the compositions of Greer et al are essentially the same as and made under essentially the same conditions as the claimed adhesive composition. Consult In re Best et al(195 USPQ 430).***

#### ***Response to Arguments***

***17) Applicant's arguments filed 03/18/02 have been fully considered but they are not persuasive.***

*Relative to Kotani et al'560 and'029—Counsel continues to argue that the compositions of Kotani et al would not be suitable as creping adhesives based on the use of the “clay component”. Firstly, the claims, in their present form, simply don't preclude the unwanted “clay mineral” since “comprising” is an open door invite for additional components. Secondly, there is nothing iron clad on this record showing that the utility of the clay-containing compositions of Kotani et al would be destroyed, i.e. not function as a creping adhesive.*

*While Counsel further argues that the adhesive compositions of Kotani et al could not operate as the claimed adhesive compositions because they are cured. It is urged that prior to curing, these compositions would operate as the claimed compositions. Counsel is reminded that a reference is evaluated, as a whole, for what it fairly teaches and is in no way limited to bits and pieces of the reference.*

*Relative to Hollenberg et al—The crux of Counsel's arguments appear to hinge on the polymers of Hollenberg et al being different in that they are crosslinked via ionic crosslinking VS the claimed polymers crosslinked via covalent bonding. Hollenberg et al teach the use of polysaccharides as operable within the scope of his invention and which necessarily implies that any polymer which falls out under the polysaccharides would, in turn, be operable. Inasmuch as polymers such as chitosan fall out under the disclosed polysaccharides, it would have been obvious to one of ordinary skill in the art to use chitosan as the polysaccharide and with a reasonable expectation of success. To this end, since the composition of Hollenberg is the same as the claimed composition, the crosslinking mechanism would presumably be the same. There is nothing viable on this record diffusing this issue. Moreover, Hollenberg et al state that the polymers of the invention “can be” ionically crosslinked(col. 1), “can be” being relative and not absolute*



*and in no way limiting. The Declaration is simply insufficient to diffuse this issue as per reasons stated in a previous Office Action, paper no. 4, 12/20/00.*

*Relative to Smigo/Hollenberg et al—It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over Smigo et al in combination with Hollenberg et al as per reasons of record.*

*The crux of Counsel's arguments appears to hinge on the amine-containing polymer/zirconium compound combination of Smigo does not engender a releasably adhesive composition that is sprayable. To this end, it is urged, to the contrary, that for reasons stated supra, the combination of Smigo et al, as modified, would possess the aforementioned properties. It is interesting to note that the claimed composition which is defined as a releasably adhesive composition that is sprayable is the same as the composition of Smigo et al in combination with Hollenberg et al. The bottom line is that there is nothing viable on this record diffusing this issue.*

#### **Conclusion**

**18) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703) 308-4346. The examiner can normally be reached on Monday-Friday, 6:30 A.M.-3:00 P.M..**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wu David can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.**

**Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2381.**

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JMR *JMR*  
June 2, 2002

*Judy M. Reddick*  
**JUDY M. REDDICK**  
**PRIMARY EXAMINER**  
*GROUP 1700*